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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,631

04/12/2004

Al Speyer

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1934

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05/08/2006

Bridgestone Americas Holding, Inc.
1200 Firestone Parkway
Akron, OH 44317

EXAMINER

FISCHER, JUSTIN R

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,631

Applicant(s)

SPEYER ET AL.

Examiner

Justin R. Fischer

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,13-15 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,13-15 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-7, and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the respective independent claims have been amended to require the tires be configured to be mounted "solely" on a left or right side. The original disclosure, however, does not include such language. There is nothing in the original disclosure that suggests that such tires cannot be mounted on either side of the tire (e.g. independent on having the word "right", such a tire can be mounted on the left side of a tire). It is additionally noted that applicant has not pointed to the original disclosure to provide support for such language. Therefore, the language is seen to constitute new matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1733

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by McGlashen (US 4,714,099). McGlashen discloses a method of manufacturing tires, wherein the tire sidewalls are provided with a directional marking or indicia that is consistent with the direction of the cords in the bead reinforcing plies (Column 2, Lines 45-60). The reference further teaches a method of mounting such tires on a racing car, such that it is desired to mount the tires on the vehicle so that the direction marks on the tires on one side of the vehicle point in the opposite direction to the direction marks on the tires on the other side of the vehicle (Column 3, Lines 15+). In such an instance, any pair of tires having opposite directional markings constitutes the tire kit of the claimed invention. It is noted that the language "solely" is not seen to limit the claim in that any tire can be physically mounted on a left or right side of a tire. Lastly, there is nothing of record to distinguish the marking of McGlashen from the claimed "high visibility indicia".

It is further noted, in regards to the method of mounting a racing car, that McGlashen teaches that tires on the same side of the vehicle should have the same direction markings. Thus, upon mounting a pair of front tire, the remaining two, rear tires would constitute a kit formed of two tires that are configured to be solely mounted on respective sides of the tire.

Regarding claims 3 and 5, the directional marking depicted in Figure 1 can be viewed as a company logo, ornamental design, or decorative pattern.

Art Unit: 1733

5. Claims 13-15 and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by Smith (GB 2,381,367). Smith discloses a pneumatic tire construction having colored markings that may be used for advertising and/or to provide an indication of speed that can be seen by spectators (motor racing) (Page 3, Lines 25-30 and Page 4, Lines 20-25).

With respect to claims 13-15 and 24, the claims are directed to a tire construction having colored markings. In each instance, the claims contain language that defines **the intended use of the color markings**, for example to designate the points leader or the rubber compound. It is clearly evident that the tire of Smith has the capability of displaying such information. **It is emphasized that the tire of Smith is configured to display a desired advertisement, which could include any of the claimed features (Page 3, Lines 5-15).**

As to claims 16 and 17, Smith teaches that each marking can have any length, width, curvature, and orientation (Page 2, Lines 25+).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 6, 7, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGlashen and further in view of Williams (US 2,985,216). As noted above, McGlashen is directed to a method of including direction markings in the

Art Unit: 1733

sidewall regions of tires in order to provide accurate mounting. While McGlashen is silent to the use of color, it is extremely well known to form similar tire sidewall markings with color in order to increase the visibility of said marking, as shown for example by Williams (Column 1, Lines 35-65). It is emphasized that the use of color in tire sidewall markings is extremely well known and conventional in the tire industry. As such, one of ordinary skill in the art at the time of the invention would have found it obvious to form the directional markings of McGlashen with color, there being no conclusive showing of unexpected results to establish a criticality for such a construction. It is further noted that the particular selection of colors would have been well within the purview of one of ordinary skill in the art at the time of the invention.

Response to Arguments

8. Applicant's arguments filed April 27, 2006 have been fully considered but they are not persuasive.

In regards to US 4,714,099, applicant initially argues that the patent fails to disclose or suggest a high visibility marking. However, as set forth in the rejection above, there is nothing of record that distinguishes the marking of the reference from the "high visibility indicia" of the claimed invention. Second, applicant argues that the patent fails to disclose a tire having indicia that requires such tire to be mounted solely on the left side or solely on the right side. As detailed above, such an amendment constitutes new matter. Additionally, the tires of the invention, in an analogous manner to those of the reference, can be physically mounted on either side of the tire, independent of the side identified by the indicia. Lastly, as set forth in the rejection

Art Unit: 1733

above, upon mounting the front pair of tires, the remaining pair of tires constitute a kit in which the respective tires are configured to be solely mounted on the left or right side of the tire.

As to claims 3 and 5, the small arrow of US '499 can be viewed as a trademark, company logo, and/or decorative pattern. Again, there is nothing of record that distinguishes the marking of the patent from being viewed as one of the above objects.

With respect to '367, applicant argues that the reference fails to disclose color markings that indicate to the racing audience the rubber composition of the tire, the points leader of a vehicle racing series, or the pole position holder of a racing event. It is emphasized that in each instance, the specific scenario represents the intended use of the color markings- such a limitation does not further define the structure of the claimed tire article. It is clearly evident that the color markings of '367 are capable of conveying any piece of information, including each of the disclosed by the claimed invention. It is not required for the reference to specifically suggest the inclusion of color markings for the reasons noted above as such limitations do not further define the claimed tire construction.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1733

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R. Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Justin Fischer

May 4, 2006